## REMARKS

In view of the above amendments and following remarks, Applicants request favorable reconsideration and allowance of the above-identified application.

Claims 1-6 remain pending in this application, with claims 1 and 4 being independent. By this Amendment, Applicant has amended claims 1 and 4-6. Support for these amendments can be found in the application, as originally filed. No new matter has been added.

To correct formal errors in the specification, a substitute specification including an Abstract, is submitted herewith. In addition to the substitute specification, a marked-up copy of the original specification, showing the portions thereof that are being changed, is also submitted. The substitute specification includes the same changes that are indicated in the marked-up copy. No new matter has been added by the substitute specification.

Claim 1 stands rejected under 35 U.S.C. § 103(a), as being unpatentable over JP 2002-2212413A (Sumitomo Rubber) in view of JP 2002-105305A (Hattori). Additionally, dependent claims 2-6 stand rejected under 35 U.S.C. § 103 as being unpatentable over two or more of Sumitomo Rubber, Hattori, U.S. Patent No. 5,393,467 (Yabushita et al.), U.S. Patent No. 5,666,615 (Nguyen), U.S. Patent No. 6,144,830 (Kusaba et al.), and U.S. Patent No. 4,841,336 (Kusumoto et al.). Applicants traverse these rejections.

As recited in independent Claim 1, Applicants' invention is directed to a charging member for charging a surface of a member to be charged in an image-forming apparatus under application of a voltage. The charging member has an outermost surface layer containing a conductive elastic material. The conductive elastic material comprises a polymer, and at least 70% by weight based on the total weight of the polymer is a polar polymer. The polar polymer primarily comprises acrylonitrile butadiene rubber, an ethylene oxide-propylene oxide-allyl glycidyl ether terpolymer, and a homopolymer of epichlorohydrin. Weights x, y and z of the acrylonitrile butadiene rubber, ethylene oxide-propylene oxide-allyl glycidyl ether terpolymer, and homopolymer of epichlorohydrin, respectively, in the polar polymer have a relationship of $0.2 \leq y/(x+y+z) \leq 0.5$ and $4.7 \leq y/z \leq 20$.

Sumitomo Rubber discloses a conductive rubber composition in which an ethylene oxide-propylene oxide-allyl glycidyl ether copolymer is blended with acrylonitrile butadiene rubber in a weight ratio of 70:30 to 5:95. The conductive rubber composition can be used to form a conductive roller. However, the Examiner recognizes that Sumitomo Rubber does not teach or suggest a rubber composition comprising epichlorohydrin.

Hattori relates to a conductive rubber roller having a conductive rubber composition of ethylene oxide-propylene oxide-allyl glycidyl ether terpolymer and epichlorohydrin blended in a weight ratio 0.01 to 4.00.

Although Sumitomo Rubber is understood to describe a conductive roller comprising ethylene oxide-propylene oxide-allyl glycidyl ether copolymer and acrylonitrile butadiene rubber and Hattori is understood to describe a conductive roller comprising ethylene oxide-propylene oxide-allyl glycidyl ether terpolymer and epichlorohydrin, Applicants submit that there is no motivation or suggestion in either reference to substitute the rubber composition of Hattori for the ethylene oxide-propylene oxide-allyl glycidyl ether copolymer of Sumitomo Rubber. Sumitomo Rubber is understood to teach only use of a mixture of ethylene oxide-propylene oxide-allyl glycidyl ether copolymer and acrylonitrile butadiene rubber. Moreover, as should be appreciated from Applicants' examples and comparative examples (set forth in the specification at pages 29-50), the structure and performance of a conductive rubber composition composed of a polymer mixture changes greatly depending on the composition and weight ratio. Thus, Applicants submit that the result of combining the composition of Hattori with the composition of Sumitomo Rubber would be unclear to one of ordinary skill in the art.

In this regard, it is well settled that the mere fact that teachings found in the prior art could be combined as proposed by the patent Examiner does not make the combination obvious to one having ordinary skill in the art, absent some teaching, suggestion, or incentive supporting the proposed combination.

Applicants' own disclosure cannot be used as a road map to realize the claimed combination. Applicants submit that there is nothing in the cited art which suggests combining the elements in the manner suggested in the Office Action. Even if the art could be so combined, the mere fact that the art can be combined is not sufficient to invalidate a claim if there is no suggestion in the art that such a combination is desirable, *see ACS Hospital Systems Inc. v. The Montefiore Hospital*, 221 USPQ 929, 933 (Fed. Cir. 1984).

Moreover, Applicants submit that even if Sumitomo Rubber and Hattori were considered in combination, that combination fails to teach or suggest many features of Applicants' invention, set forth in claim 1. Specifically, nothing in Sumitomo Rubber or Hattori teaches or suggests a polar polymer primarily comprising acrylonitrile butadiene rubber (weight x), an ethylene oxide-propylene oxide-allyl glycidyl ether terpolymer (weight y), and a homopolymer of epichlorohydrin (weight z), which satisfies the relationship of $0.2 \leq y/(x+y+z) \leq 0.5$ and $4.7 \leq y/z \leq 20$.

Yabushita et al. discloses a rubber composition comprised of a diene type of rubber and a rubber containing no double bond in its principal chain, which are cross-linked with a metallic salt cross-linking agent. Nguyen describes an electrophotographic development process using a liquid toner with ethylene-vinyl acetate as a binder resin. Kusaba et al. relates to an eletrophotographic process using an intermediate transfer belt, and Kusumoto et al. relates to an image forming apparatus capable of accommodating developing devices. None of these secondary references remedy the deficiencies noted above, as discussed with respect to Claim 1.

Thus, independent claim 1 recites features that patentably define over the citations of record. Reconsideration and withdrawal of the § 103 rejections are respectfully requested.

Claims 2-6 depend from claim 1. These dependent claims are believed allowable by virtue of their dependency, and for defining other patentable features of the invention. Individual and favorable reconsideration of the dependent claims are requested.

Applicants submit that the present application is in condition for allowance. Favorable reconsideration, withdrawal of the rejections set forth in the above-noted Office Action, and an early Notice of Allowance are requested.

Applicants' undersigned attorney may be reached in our Washington, D.C. office by telephone at (202) 530-1010. All correspondence should continue to be directed to our below listed address.

Respectfully submitted,

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